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PATENT

Attorney Docket No: 27373/34978A

1646  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Linquist et al.

Application No. 09/591,632

Filed: June 9, 2001

For: "RECOMBINANT PRION-  
LIKE GENES AND PROTEINS  
AND MATERIALS AND  
METHODS COMPRISING  
SAME"

Group Art Unit: 1646

Examiner: M. Brannock

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
Washington, DC 20231

Sir:

In a communication dated April 9, 2002, the Patent Office alleged that the claims pending in the above-identified application were directed to six distinct inventions and required restriction under 35 U.S.C. §121. Reconsideration is respectfully requested in view of the following remarks.

## **I. Election**

The Applicants hereby elect Group V (claims 65-67, 81, 101-110, and 115-118), drawn to polypeptides having a reactive SCHAG amino acid sequence.

With respect to election of species, the Applicants hereby elect *S. cerevisiae* Sup35 polynucleotides and polypeptides (SEQ ID NO:2), and more particularly the NM regions (residues 1-253) and still more particularly the N region (amino acids 1-123) of this sequence. If election of a single modification is required, the Applicants hereby elect substitution of a cysteine residue into the Sup35 sequence (see, e.g., Table 1 at p. 86 of the application).

The Patent Office further alleged that if Group V claims were elected, a species of substituent from the substituents recited in claim 109 must be elected. The Applicants elect a metal atom substituent as recited in claim 110.

## **III. Traversal of Restriction**

Groups V and VI are related in that the polynucleotides of Group VI encode the polypeptides of Group V. The Examiner alleges that the materials can be isolated or purified from natural sources, but in fact a modification requiring substitution of a reactive group is recited in the claims. Because Groups V and VI each involve a common modification which distinguishes them from naturally occurring subject matter, they are sufficiently inter-related that they should be examined together.

Moreover, as explained in the previous amendment, examination of the Group IV claims at the same time as the elected claims would involve no undue burden because the claims are related as a method of making and a product made. A thorough search of one group would likely share common attributes with a thorough search of the other. The restriction requirement fails to articulate a recognized basis for restricting Group IV from Groups V and VI.

Irrespective of the merits of the restriction, the Applicants request fair consideration of their generic claims and allowance of a reasonable number of species within the scope of novel and unobvious genus claims.


Finally, the Applicants respectfully submit that election of a substituent with respect to Group V is inappropriate insofar as the generic claims do not require a substituent per se. (See, e.g., claim 101.)

**CONCLUSION**

For the reasons set forth above, the Applicants respectfully request examination of Groups IV and VI together with elected Group V, and request prompt and favorable consideration on the merits.

Respectfully submitted,

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May 9, 2002